PATENT
Customer No. 22,852
Attorney Docket No. 07937.0003-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Application of: | ) | |
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| John KEANE et al. | ) | Group Art Unit: 2144 |
| | ) | |
| Application No.: 10/078,366 | ) | Examiner: Joseph R. Maniwang |
| | ) | |
| Filed: February 21, 2002 | ) | |
| | ) | |
| For: METHODS AND SYSTEMS FOR RESOLVING ADDRESSING CONFLICTS BASED ON TUNNEL INFORMATION | ) | Confirmation No.: 4963 |

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Sir:

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action mailed December 1, 2006. This Request is being filed concurrently with a Notice of Appeal.

### I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants have met each of the requirements for a pre-appeal brief review of the rejections set forth in an Office Action. The application has been at least twice rejected. Applicants have filed a Notice of Appeal with this Request, and have not yet filed an Appeal Brief. Applicants submit this Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005. Therefore, Applicants request review of the Examiner's rejections in the Final Office Action for the following reasons.

## II. Status of the Claims

In the Final Office Action, the Examiner rejected claims 1-43 and 45-56 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,028,334 to Tuomenoksa ("*Tuomenoksa*").

## III. The rejection of claims 1-43 and 45-66 under 35 U.S.C. § 102(e) as being anticipated by *Tuomenoksa* is improper

Applicants respectfully request that the Board of Examiners reconsider and withdraw the rejection of claims 1-43 and 45-66. In order to properly establish that *Tuomenoksa* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites an method including, for example:

> associating an identifier with the detected addressing conflict;

(emphasis added). *Tuomenoksa* does not teach or suggest at least these claim elements.

*Tuomenoksa* discloses "a network 1800 including one or more client computers 1824, 1823 connected to a hub 1822 that interfaces a first gateway 1821" (col. 47, lines 14-16). "The network may also include one or more client computers 1834, 1833 that are connected to a hub 1832 interfacing a second gateway 1831" (col. 47, lines 19-22). If an address conflict between the first gateway 1821 and the second gateway 1831 exists, "the first gateway 1821 may propose a first intermediate address space" and the "second gateway 1831 may propose a second intermediate address space" (col. 48, lines 54-57).

The Examiner cites col. 48, lines 23-46 as allegedly corresponding to the claimed "associating an identifier with the detected addressing conflict" (Final Office Action at page 2). The Examiner also asserts that intermediate address space in *Tuomenoksa* "is equivalent to the claimed identifier associated with a detected addressing conflict" (Final Office Action at page 8). This is not correct.

Col. 48, lines 23-46 of *Tuomenoksa* discloses address conflicts that may occur because "locally assigned IP addresses associated with the clients 1823, 1824 of the first gateway 1821 may be identical and thus may conflict with the locally assigned IP addresses associated with the clients 1833, 1834 of the second gateway 1831. This address conflict may be possible because the IP addresses of the client computers 1824, 1823 may be private or local addresses that are routable within the local area network served by the first gateway 1821" (col. 48, lines 29-37). This passage provides an overview of a situation when address conflicts may exist (i.e. when assigned IP addresses are identical). However, this passage does not teach or suggest "associating an identifier with the detected addressing conflict."

IP addresses destined for the second gateway 1831 of *Tuomenoksa* may be converted into a first intermediate space, and IP addresses destined for the first gateway 1821 may be converted into a second intermediate address space (col. 49, lines 20-31). The intermediate address spaces in *Tuomenoksa* are locations for converted IP addresses. Such a location does not constitute an "identifier." Therefore, *Tuomenoksa* does not teach or suggest a method for resolving an addressing conflict including "associating an identifier with the detected addressing conflict," as recited in claim 1.

*Tuomenoksa* fails to teach the claimed subject matter, including at least these elements. Accordingly, *Tuomenoksa* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons. Claims 2-14, 36-43, and 56 are also allowable at least due to their depending from claim 1.

Independent claims 15 and 26, while of different scope, recite limitations similar to those of claim 1 and are thus allowable over *Tuomenoksa* for at least the same reasons discussed above in regard to claim 1. Claims 16-25 and 45-53 are also allowable at least due to their dependence from claim 15, and claims 27-30 are also allowable at least due to their dependence from claim 26.

Regarding the rejection of claim 31, the Examiner includes claim 31 in the rejection of independent claims 1, 15, and 26 (Office Action at page 2). However, claim 31 includes recitations not found in claims 1, 15, and 26. For example, claim 31 includes the recitation of: "a processor other than the first and second processors that

detects a conflict between the first address and the second address prior to communication between the first processor and the second network." *Tuomenoksa* does not disclose this element.

37 C.F.R. § 1.104(c) requires the Examiner to provide more than merely stating a reference meets the limitations of a rejected claim. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 C.F.R. § 1.104(c)(2). In this case, the reference asserted by the Examiner is complex and describes many different embodiments. Moreover, the Examiner improperly ignores recitations of claim 31. The Examiner's rejection of claim 31 under 35 U.S.C. § 102(e) does not meet the requirements of 37 C.F.R. § 1.104. Here, by ignoring the recitations of claim 31, the Examiner has failed to show how the cited art teaches or suggests the elements of this claim. As a result, the rejection of claim 31 does not meet the requirements of at least 35 U.S.C. § 102(e), and thus is improper.

In *Tuomenoksa*, "an address conflict may be detected when the first gateway 1821 establishes a tunnel to the second gateway 1831" (col. 48, lines 47-48). "The first gateway 1821 and the second gateway 1831 may provide the range of addresses in the first intermediate address space and the second intermediate address space, respectively, to the network operations center" (col. 49, lines 12-15). "Consequently, each gateway may be responsible for determining if a local address conflict exists with another gateway; resolving the address conflict; and translating addresses of the packets . . ." (col. 49, lines 31-36).

In *Tuomenoksa*, a first gateway and a second gateway may be responsible for determining and resolving conflicts between the first and second gateways. However, *Tuomenoksa* does not teach or suggest "a processor other than the first and second processors that detects a conflict between the first address and the second address prior to communication between the first processor and the second network," as recited in claim 31.

*Tuomenoksa* fails to teach the claimed subject matter, including at least these elements. Accordingly, *Tuomenoksa* cannot anticipate claim 31. Thus, claim 31 is allowable for at least these reasons. Claims 32-35, 54, and 55 are also allowable at

least due to their dependence from claim 31. Applicants request that the Board of Examiners withdraw the rejection of claims 1-43 and 45-66.

## IV. Conclusion

Because the Examiner's rejections of claims 1-43 and 45-66 include legal deficiencies, Applicants are entitled to a pre-appeal brief review of the Final Office Action. Based on the foregoing arguments, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Respectfully submitted,

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Dated: February 12, 2007

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